

ESTTA Tracking number: **ESTTA638001**

Filing date: **11/10/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

|                                       |   |
|---------------------------------------|---|
| Name                                  | Think Schuhwerk GmbH                          |
| Granted to Date of previous extension | 11/09/2014                                    |
| Address                               | Hauptstraße 35<br>Kopfling, A-4794<br>AUSTRIA |

|                      |  |
|----------------------|--|
| Attorney information | Ellen A. Rubel<br>Moore & Van Allen PLLC<br>3015 Carrington Mill Blvd., Suite 400<br>Morrisville, NC 27560<br>UNITED STATES<br>EAR-PTOTMCorrespondence@mvalaw.com, ellenrubel@mvalaw.com<br>Phone:919-286-8041 |
|----------------------|--|

### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85921674  | Publication date       | 05/13/2014 |
| Opposition Filing Date | 11/10/2014  | Opposition Period Ends | 11/09/2014 |
| Applicants             | <p>McLaughlin, Joseph<br/>100-60 198th St.<br/>Jamaica, NY 11423<br/>UNITED STATES</p> <p>McLaughlin, Jonah<br/>100-60 198th St.<br/>Jamaica, NY 11423<br/>UNITED STATES</p> <p>Sennon, Kevin<br/>623 Hinsdale St.<br/>Brooklyn, NY 11207<br/>UNITED STATES</p> <p>Kerr, Jawara Anthony<br/>11216 197th St.<br/>St. Albans, NY 11412<br/>UNITED STATES</p> <p>Hoyte, Karim<br/>196-18 112th Avenue<br/>St. Albans, NY 11412<br/>UNITED STATES</p> |                        |            |

## Goods/Services Affected by Opposition


Class 025. First Use: 2012/04/26 First Use In Commerce: 2012/08/26

All goods and services in the class are opposed, namely: clothing for men, women and children, namely, shirts, golf shirts, T-shirts, sweat shirts, tank-tops, sweaters, jerseys, shorts, sweat pants, cargo pants, warm-up suits, pants, jeans, hats and baseball caps


## Grounds for Opposition

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

## Marks Cited by Opposer as Basis for Opposition

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3831969   | Application Date      | 12/13/2006 |
| Registration Date     | 08/10/2010  | Foreign Priority Date | NONE       |
| Word Mark             | THINK   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 018. First use: First Use: 0 First Use In Commerce: 0<br>Backpacks<br>Class 025. First use: First Use: 0 First Use In Commerce: 0<br>Footwear |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2826851                                     | Application Date      | 02/20/2001 |
| Registration Date     | 03/30/2004                                  | Foreign Priority Date | NONE       |
| Word Mark             | THINK! WELLFORMED SHOES FOR NATURAL WALKING |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         |   |
| Description of Mark | NONE  |
| Goods/Services      | Class 025. First use: First Use: 1997/11/00 First Use In Commerce: 1997/11/00 Footwear, shoes [ ; clothing, namely, belts, dresses, shirts, pants and underwear for men, women and children ] |

|                     |   |
|---------------------|---|
| Related Proceedings | Opposition to Applicant's co-pending U.S. Application, Serial No. 85/921,577, filed November 10, 2014 on behalf of Think Schuhwerk GmbH |
| Attachments         | 79040612#TMSN.png( bytes )<br>76212669#TMSN.png( bytes )<br>Notice of Opposition to THINK ABOUT IT! & Design.PDF(220965 bytes )         |

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                |
|-----------|----------------|
| Signature | /ellenarubel/  |
| Name      | Ellen A. Rubel |
| Date      | 11/10/2014     |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial Number: 85/921,674

Published in the Official Gazette: May 13, 2014

Think Schuhwerk GmbH,  
Opposer,

V.

Karim Hoyte, Jawara Anthony Kerr, Jonah McLaughlin, Kevin Sennon and Joseph McLaughlin

## Applicants

## Opposition Number

## NOTICE OF OPPOSITION

Think Schuhwerk GmbH (hereinafter “Opposer”), a limited liability company organized and existing under the laws of Austria and having a principal place of business at Hauptstraße 35 Kopfing, Austria A-4794 (hereinafter “Opposer”), believes that it will be damaged by registration of the mark shown in Application Serial Number 85/921,674 in International Class 25 (hereinafter “Applicants’ Application”) and hereby opposes the same.

This Notice of Opposition is based on 15 U.S.C. § 1063 et seq. and is timely submitted following Opposer's timely and appropriate filing of a 90-Day Request for Extension of Time to Oppose and its timely and appropriate filing of a subsequent 60-Day Request for Extension of Time to Oppose Upon Consent, both requests having been granted by the Trademark Trial and Appeal Board. The grounds for the opposition are as follows:

1. Opposer owns U.S. Registration No. 3,831,969 for the trademark THINK in connection with, among other things, footwear in International Class 25.

2. Opposer's trademark registration, Registration No. 3,831, 969, is a valid, subsisting, unrevoked and uncanceled registration.

3. Opposer has continuously used its THINK trademark in U.S. commerce in connection with shoes since at least as early as 1998.

4. Opposer owns U.S. Registration No. 2,826,851 for the trademark THINK! WELLFORMED SHOES FOR NATURAL WALKING and Design in connection with footwear, shoes.

5. Opposer's trademark registration, Registration No. 2,826,851, is an incontestable, valid, subsisting, unrevoked and uncanceled registration.

6. Opposer has continuously used its trademark THINK! WELLFORMED SHOES FOR NATURAL WALKING and Design mark in U.S. commerce in connection with shoes since at least as early as November, 1997.

7. Opposer has spent substantial amounts of time, money and effort in developing its trademarks, THINK and THINK! WELLFORMED SHOES FOR NATURAL WALKING and Design (hereinafter, collectively, "Opposer's Marks") in connection with, among other things, footwear and shoes (hereinafter "Opposer's Goods") and in marketing Opposer's Goods under Opposer's Marks in the United States.

8. Through Opposer's marketing efforts and sales, Opposer has established a prominent presence in the marketplace in the United States, and internationally, and has built significant goodwill in Opposer's Marks.

9. Karim Hoyte, Jawara Anthony Kerr, Jonah McLaughlin, Kevin Sennon and Joseph McLaughlin (hereinafter “Applicants”), who on information and belief are United States citizens, seek to register the mark THINK ABOUT IT! and Design (hereinafter “Applicants’ Mark”) as a trademark for the following goods in International Class 25: “clothing for men, women and children, namely shirts, golf-shirts, T-shirts, sweat shirts, tank-tops, sweaters, jerseys, shorts, sweat pants, cargo pants, warm-up suits, pants, jeans, hats and baseball caps” (hereinafter “Applicant’s Goods”) as evidenced by publication of said mark in the *Official Gazette* on May 13, 2014.

10. Applicants’ Application was filed under the actual use provisions of 15 U.S.C. §1051(a), including as dates of use for Applicants’ Goods an alleged date of first use anywhere of April 26, 2012 and an alleged date of first use in commerce of August 26, 2012.

11. On information and belief, Applicants acquired no rights in Applicants’ Mark with the specified goods prior to April 26, 2012, when Applicant first began to use its mark.

12. There is no issue as to priority. Opposer’s Marks were used and registered in the United States by Opposer prior to the alleged first use date and the filing date of Applicants’ Applicant to register Applicants’ Mark and prior to any date upon which Applicants can rely.

13. Applicants’ Mark and Opposer’s THINK mark are visually, phonetically and connotatively similar given that Applicants’ Mark incorporates the whole of Opposer’s THINK mark, the first term and dominant portion of Applicants’ Mark is identical to Opposer’s Mark and the marks, as a whole, have the same meaning.

14. Applicant’s Mark and Opposer’s THINK! WELLFORMED SHOES FOR NATURAL WALKING and Design mark are substantially similar as the initial and dominant term in Applicants’ Mark is identical to the dominant term and initial term in Opposer’s mark and the marks each include an exclamation point.

15. Applicants’ Goods are similar or substantially related to Opposer’s Goods.

16. On information and belief, it is expected that Applicants’ Goods are or will be marketed to the same potential purchasers in the same relevant markets as are Opposer’s Goods.

17. On information and belief, it is expected that Applicant's Goods are or will be marketed and distributed through the same channels of distribution and are or will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.


18. Because of the similarity of the marks, goods, relevant markets, channels of distribution, and/or consumers, Opposer believes that there will be a likelihood of confusion if Applicants are permitted to register Applicants' Mark for use in connection with Applicants' Goods despite Opposer's preexisting and ongoing rights and interests in Opposer's Marks.

19. If Applicants are granted the registration herein opposed, Applicants would be placed in a position to deceive or mislead the public, as the registration would give Applicants *prima facie* exclusive rights to Applicants' Mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

20. Because Applicants' Mark closely resembles the Opposer's Marks, and Applicants' Mark is likely, when used in connection with Applicants' Goods, to cause confusion, to cause mistake, or to deceive consumers and the public, registration of Applicants' Mark is, therefore, barred under 15 U.S.C. §1052(d) and 15 U.S.C. §1125(a).

21. Accordingly, Opposer prays that said Application Serial No. 85/921,674 be rejected and the registration of the mark therein shown for the goods in Class 25 therein specified be refused and denied.

Respectfully submitted this 10th day of November, 2014.



Ellen A. Rubel  
N.C. Bar Number 28051  
Moore & Van Allen PLLC  
Attorney for Opposer, Think Schuhwerk GmbH  
3015 Carrington Mill Boulevard, Suite 400  
Morrisville, NC 27560  
Telephone: (919) 286-8000  
Facsimile: (919) 286-8199

**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing **Notice of Opposition** has been served this day by depositing a copy thereof in a depository under the exclusive care and custody of the United States Postal Service in a postage prepaid envelope and properly addressed as follows:

Dwayne L. Bentley  
DL Bentley Law Group PLLC  
26 Court Street  
Suite 405  
Brooklyn, New York 11242-1134

This the 10th day of November, 2014.

Moore & Van Allen PLLC



Ellen A. Rubel  
N.C. State Bar No. 28051  
Attorney for Opposer, Think Schuhwerk GmbH  
3015 Carrington Mill Boulevard, Suite 400  
Morrisville, NC 27560  
Telephone: (919) 286-8000